In the Supreme Court of the United States

No. 988.

OCTOBER TERM, 1970.

MINNESOTA MINING AND MANUFACTURING COMPANY,

Petitioner,

vs.

NORTON COMPANY,
STUDEBAKER-PACKARD CORPORATION,
HADCO CORPORATION,

Respondents.

CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

PETITION FOR REHEARING.

Minnesota Mining and Manufacturing Company petitions for rehearing of this Court's February 22, 1971, order denying certiorari.

Conflict has developed on the central issue of "obviousness" (on which Hoover Patent, U. S. No. 2,958,593, was in this case held invalid) between the Sixth Circuit's decision in this case and the Seventh Circuit's decision of January 21, 1971, in *Illinois Tool Works, Inc. v. Sweetheart Plastics, Inc.*, 168 USPQ 451, reported in the United

States Patent Quarterly of February 22, 1971—the very day on which this Court denied certiorari in the present case.

In the present case, the patent is held invalid—as "obvious," in the Sixth Circuit's view—even though *the 13-month struggle of the accused infringer to produce its copy* demonstrates that the secret of the Hoover abrasive article was not "obvious" even to Norton, the accused infringer, the world's largest manufacturer of abrasive devices. To unlock the secret of Hoover, Norton (when it obtained a copy of the Hoover article three days after it appeared on the market) assigned—not just one—*but nine*, skilled researchers to analyze the Hoover product. They had the Hoover article to work on—*but not the patent*, for it was not to issue until two years and nine months later. They recorded their researches in 371 pages of 17 laboratory notebooks and 75 memoranda (1459a-1468a, 1277a-1289a, 1132a-1133a) and thereby achieved Norton's copy of Hoover.

In the Seventh Circuit case, on the other hand, the patent is held valid *on precisely the same point* and under like circumstances of prolonged struggle by the infringer to achieve its copy—taken by the Seventh Circuit as proof that the invention was *not* "obvious." In the Seventh Circuit's view:

> "Davis was unable to produce [for the accused infringer] a successful vending cup of the type here at issue for a considerable period after he was assigned the task of designing such a container even though the '360 design was incorporated into one of plaintiff's cups which was already on the market and widely advertised in trade journals contemporaneously with Davis' endeavors. While *that fact alone seems sufficient to indicate that the '360 invention*

was not obvious from the prior art's teachings, we note further that, while the use of interrupted, reverse tapered stacking rings and unitary thinwall plastic construction were well-disclosed in the art long before Edwards invented the cup later patented under '360, no other previous inventor had either combined these two concepts or produced a plastic container satisfactory for use in automatic hot beverage dispensing.

Defendants have stated (and plaintiff has conceded on oral argument) that if certain features of the Caine cup and the Miller cup were united in one structure the result would be the '360 container. But that *merely begs the question of obviousness and invites us to participate in more than a little of the omniscience that hindsight always allows.* We believe it is far more telling that not only did Davis fail to outrace Edwards to the market place or the Patent Office with an operative product like the '360 invention, but Miller, Politis (who introduced Edwards to sheet thermoforming of plastic cups) and defendants' witness Pfohl *also failed* to do so as apparently did all others skilled in the art. We conclude that the '360 invention was not obvious from the prior art." 168 USPQ at 456-457.

The parallel is remarkable.

Only the result is different.

In the present case, not only was Respondent Norton baffled but so was Fiber Bond, a division of Union Carbide Corporation. It was unable to reproduce the Hoover article *at all* until after the patent had issued—and, when it and its parent Union Carbide were sued for infringement, they acknowledged the validity of the patent and became licensees and have been paying royalties for seven years.

The conflict in the circuits ought to be resolved.

It is not right that important property rights turn on the accident of suit in one circuit rather than another.

Respectfully submitted,

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March 16, 1971.

CERTIFICATE OF COUNSEL.

Thomas V. Koykka, counsel for Petitioner, Minnesota Mining and Manufacturing Company, certifies that this petition for rehearing is presented in good faith, not for delay, and in the conviction that it should be granted. The petition for rehearing is restricted to, and based on, the intervening circumstance of the appearance of a conflicting decision in the Seventh Circuit on a point of critical and controlling effect.

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